



REMARKS

This is a full and timely response to the Official Action mailed January 5, 2006. Reexamination and reconsideration of the rejections set forth therein in light of the following remarks are courteously requested. Claim 63 has been added for consideration by the Patent and Trademark Office. It finds basis in the Specification in original claim 5.

By the foregoing, claims 1-10 are currently pending for the Examiner's consideration. The Office Action of January 5, 2006 rejected Claim 1 under 35 U.S.C. 112, first paragraph, on the following basis:

...because the specification, while being enabling for botanical families of leguminosae, solanaceae, gramineae, and cucurbitaceae, does not allegedly reasonably provide enablement for **all nondenatured botanical extract**. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make or use the invention commensurate in scope with these claims. [Office Action, p. 2-3] (emphasis added)

Applicants respectfully request reconsideration of this rejection for at least the following reasons.

The Office Action alleges that "the specification does not reasonably provide enablement for **all nondenatured botanical extracts**." (emphasis added) In response, applicants respectfully submit that the claim does not describe **all nondenatured botanical extracts**. Rather, the claim relates to nondenatured botanical extracts **having trypsin-inhibiting activity**. As set forth in *Vas-Cath Inc. v. Mahurkar*, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991): "The invention is, for purposes of the 'written description' inquiry, whatever is now claimed."

The composition comprises **specific** botanical extracts families, **rather than** "all nondenatured botanical extracts" as set forth in the Office Action. Specifically, the specification describes nondenatured plant extracts **having trypsin inhibitory activity** and a natural or synthetic retinoid or retinol compounds. [See, e.g., Specification p. 6, l. 10-25]. Preferably, the compositions of this invention contain nondenatured legume or vegetable extracts containing compounds that inhibit trypsin, such as serine protease inhibitors. In particular, nondenatured legume extracts will also be useful in methods of this invention. More preferably, nondenatured soybean, limabean and blackbean extracts, and other natural products made from these beans, such as, but not limited to, bean milk, bean paste, and the like, also serve to reduce pigmentation

by this mechanism. Serine protease inhibitors isolated from vegetables or legumes are also useful in this invention, such as, but not limited to, the soybean-derived proteins soybean trypsin inhibitor, "STI" and Bowman-Birk Inhibitor, "BBI". Thus, one of ordinary skill in the art would understand that Claim 1 describes such particular types of extracts, not **all** nondenatured botanical extracts.

In view of the foregoing discussion, applicants respectfully request reconsideration of the rejection of Claim 1 under 35 U.S.C. 112, first paragraph.

The Office Action further rejected Claim 1 under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The Office Action alleges that "claims employing method for treating skin condition with synthetic retinoids" has not been described within the specification. The Office Action also alleges that "[t]here is no description in the specification for ring systems of formula I contemplated."

In response to this allegation, applicants respectfully submit that the requirements of 35 U.S.C. 112, first paragraph, have been realized within the application. In particular, please note that the original Specification exemplifies the use of tretinoin, a retinoid which can occur naturally or be made synthetically and which is representative of retinoid activity in, for example, Example 8, p. 22, l. 24 through p. 24, l. 6, and Example 9, p. 24, l. 7-29. Other synthetic retinoids would exhibit similar retinoid activity. As set forth in *Musco Corp. v. Qualite Inc.*, 41 USPQ2d 1954 (Fed. Cir. 1997). [See also MPEP 2164.01]:

...section 112 requires only an objective enablement; the invention needs to be sufficiently disclosed through illustrative examples or terminology to teach those of ordinary skill in the art how to make and how to use the invention as broadly as it is claimed.

With respect to the reference to "ring systems of formula I", applicants respectfully request clarification as they do not find this language within Claim 1.

In view of the foregoing discussion, applicants respectfully request reconsideration of the rejection under 35 U.S.C. 112, first paragraph.

For the foregoing reasons, applicants respectfully submit that the above-captioned

application is now clearly in condition for allowance. Accordingly, favorable reconsideration of the above remarks and an early Notice of Allowance are courteously solicited. If the Examiner has any comments or suggestions that could place this application in even better form, the Examiner is requested to telephone the undersigned Attorney at the below-listed number.

If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 10-0750.

Respectfully submitted,

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